APPENDIX

Excerpts From August 15, 1969 Report of the Special Master in Misc. Civil Action No. 35 (D. Del.)

The allegedly protected documents (when fully assembled) filled 19 heavy cardboard file folders and 7 full cartons. The index of the documents was presented in two 250-page folio sized black volumes. . . . The total pages reviewed . . . have been approximately 14,200. (pp. 2-3)

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In Re Natta (3rd Cir. 1969) 410 F.2d 187 was an earlier stage of This Action. The holding of that case upheld a claim of work product for four letters. Three of the letters were from DuPont house counsel to DuPont management personnel and analyzed DuPont's interference case and evaluated its prospects. One was a letter from DuPont house counsel to a retained DuPont attorney also analyzing DuPont's case in the interference.

The Court of Appeals rejected Montecatini's assertion that work product and attorney-client privilege were offensive to public policy in patent solicitation situations:

> "We cannot conclude, however, that the proper application of work product and attorney-client privilege will be detrimental to the public interest or offend paramount federal patent policy, whenever a patent solicitation is involved." 410 F.2d 187, 190-1

The Court of Appeals was unequivocal in its rejection of the *Zenith* rule as regards patent solicitation. I conclude, therefore, that lawyers engaged in patent solicitation, turned out by Judge Leahy, have been welcomed back into the profession by Judge Layton and the Court of Appeals. The Court of Appeals said:

> "We have carefully examined appellant's attempts to show the absence of justification for the application of

attorney-client privilege and the work product doctrine where patent procurements by corporations are involved. We hold that in a particular situation both attorney-client and work product immunity may be available to the solicitation of a party's own patent. We reject the absolute rule urged by appellant. We deem it wise that flexibility be maintained and that sound judicial discretion be exercised on a case by case basis." 410 F.2d 187, 191

DuPont contends, however, that there remains a distinction between *ex parte* and *inter partes* patent solicitation. Documents arising out of *ex parte* proceedings (solicitation before the examiner, for example) would be exempt from protection under DuPont's formulation and those arising out of *inter partes* proceedings (interferences) would be protected. An examination of the briefs before the Court of Appeals shows that this point was discussed by the parties (Appellees' Brief, page 35; Appellants' Reply Brief, page 3; [15]). I find no such distinction in the Court of Appeals' opinion. . . . (pp. 11-13)

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[15] Montecatini says the point was covered in oral argument as well: . . . .

Excerpts From the July 16, 1969 Oral Opinion of the District Court for the Northern District of Illinois in Civil Action No. 66 C 1221

I have reviewed sheet by sheet each of the documents submitted in conjunction with the listing of April 11, 1969. . . .

I have reviewed in minute detail the sixty volumes of notes referred to in Standard's letter of July 11, 1969,

* * * * *

The final and reduced legal question before me is this: Is the public interest of such nature in this proceeding to permit the claim that there should be full disclosure at the

expense of both the lawyer-client privilege and the work product rule of Hickman vs. Taylor.

In this respect, I adopt the language of Judge Breitenstein in Natta vs. Hogan, 392 Fed. 2d 686, Tenth Circuit, 1969, at pages 691 and 692, wherein he stated:

> "We recognized that in patent proceedings the applicant must observe the highest degree of candor, honesty and good faith. In our opinion this does not foreclose the assertion of a claim of privilege in a patent proceeding. The attorney-client privilege is designed to facilitate the administration of justice in order to promote freedom of consultation of legal advisers by clients. We see no reason why this long-established principle should not be applied to patent cases."

Further, in this respect, I adopt the language of Circuit Judge McLaughlin, and his brethren of the Third Circuit, Judges Hastie and Stahl, in their Case No. 17524, rendered on April 18, 1969, in In Re Natta, et al., when on page 6 of the Slip Opinion to that case they said:

> "Although Judge Breitenstein was referring to attorney-client privilege, we are of the opinion that the same sound reasoning should be adopted with respect to the attorney work product doctrine."

Having found in fact and at law all of the documents presented to me for review in camera to be either materials coming under the lawyer-client privilege or the attorney work product doctrine—and having found the applicable law under the circumstances of this case that such privilege and doctrine shall in this proceeding not give way to the doctrine of full disclosure—on the matter of the materials reviewed in camera, I find for Standard and against Natta, and it is so adjudged and decreed that production thereof will not be ordered.

Excerpt From the June 30, 1969 Decision of the Patent Interference Examiner (Paper No. 427) in Interference No. 89,634

[I]n view of the public interest in minimum delay it is considered to be desirable and orderly to permit Natta et al. to request the setting of a special testimony time prior to the resetting of the junior parties' rebuttal testimony times. . . . Contrary to the arguments presented by the junior parties, the Patent Interference Examiner does not find that the facts set forth constitute an absence of diligence on the part of Natta et al. (pp. 7-8)

Petition Decision of the First Assistant Commissioner of Patents of July 30, 1969 in Interference 89,634

This is a petition by the party Baxter et al. from the action of the Examiner of Patent Interferences, on June 30, 1969, permitting Natta et al. to renew their request for the setting of a special testimony period.

Although based on the contention that Natta et al. have been dilatory, the present petition was filed on July 22, 1969, more than twenty days after the action complained of, and is therefore subject to dismissal under Rule 244(d). It has however, been considered to the extent of determining that the action of the Examiner involves no reversible error, and is accordingly denied.

Petition Decision of the First Assistant Commissioner of Patents of July 31, 1969 in Interference 89,634

Upon further consideration of the decision rendered July 30, 1969 in the above case, it is noted that July 21, 1969 was regarded as a legal holiday and that the petition filed by Baxter et al. was therefore not subject to dismissal as late as indicated in the said decision. However, for the reason indicated in that decision, the denial of the petition must stand.